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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,533	09/19/2006	Shinichi Ogasawara	SCEP 22.456(100809-00319)	5458
26304 7590 01/14/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER DEODHAR, OMKAR A	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,533	Applicant(s) OGASAWARA ET AL.	
	Examiner OMKAR A. DEODHAR	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/2008, 11/7/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Final Rejection

Response to Amendment & Arguments

Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 & 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeong (US 6,813,147) in view of Mical (US 4,969,647).

Claim 1:

Jeong teaches:

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A portable electronic device, comprising:

a horizontally long casing, both ends of which are capable of being gripped by a user's both hands, respectively (Figure 1);

a display unit fit into the casing (Figure 1); and

an optical disk drive unit which has a lid opening backwards and on which a detachable optical disk is loaded (Figure 5),

wherein a planar region is provided at substantially a center of the rear face of the casing, and at least a part of the planar region constitutes the lid of the optical disk drive unit (Figure 5 – part of said planar region constitutes the lid of the disk drive),

Jeong does not teach:

and wherein curved shapes are formed symmetrically on both sides of the casing respectively so that fingers of the user gripping the casing placed along the curved shapes make the tips of the fingers point away from the center of the lid of the optical disk drive unit

(Mical teaches a hand-held electronic device with curved edges. See Mical Figure 1. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide curved edges on Jeong's device for the purpose of making it easier for a user to hold. See Mical Col. 1 Lines 53-60 for this motivation.)

Claim 3:

The portable electronic device of claims 1, wherein an outer edge of each side of the casing comprises each of the curved shapes is formed as an arc shape fitting to the curve formed by a palm of the user gripping the casing.

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(Jeong in view of Mical teaches the claimed arc shape. See Mical Figure 1.)

Claim 4:

The portable electronic device of claim 1, wherein a horizontally longitudinal cross section of the casing substantially perpendicular to the rear face comprises the curved shapes formed as a gentle curve slanted from the center of the casing to the left and right hand of the user.

(Jeong in view of Mical teaches the claimed limitations. See Mical Figure 1.)

Claim 5:

Jeong teaches:

The portable electronic device of claim 1, further comprising a first operation means (Figure 1, Item 192) and a second operation means (Figure 1, Items 190 provided on the front face of the casing, wherein each of the first operation means and the second operation means is operated by a thumb of the user gripping the casing (A person may use his thumb, or any other finger to press the buttons), the first operation means is a direction instruction key (Figure 1, Item 192 teaches instruction keys) having a plurality of pressed faces each corresponding to an operation direction (Figure 1, Item 192, instruction keys corresponding to an operation direction), the second operation means is a plurality of button keys each outputting single instruction (Figure 1, Items 190 show a plurality of keys for various instructions), and the center of the direction instruction key and the center of the button keys are shifted upward in the vertical direction from the horizontal center line of the casing when viewed from the user (the keys described above are interpreted as teaching the claimed limitations).

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Claim 6:

Jeong teaches:

The portable electronic device of claim 5, wherein when the casing is placed on a horizontal plane so that a face without the display unit is oriented downward (the bottom of the device is oriented downward), a top of the direction instruction key and a top of any one of the plurality of button keys are higher than the maximum height of the casing (since the keys are elevated with respect to the planar surface they reside on, they are interpreted as being higher than the maximum height of the casing when the optical drive is in its closed position. In this respect, the casing is interpreted as the planar region containing the disk drive & buttons; apart from the display.)

Claim 7:

Jeong teaches:

The portable electronic device of claim 5, wherein the front face of the casing comprises at least two areas, the direction instruction key and the plurality of button keys are placed in a first area (Figure 1, Items 190 & 192 are in a first area),

and at least one sub operation button not used during game play going on the display unit is placed in a second area, wherein the height of the first area and the height of the second area are different from each other when measured from a horizontal plane on condition that the casing is placed on the horizontal plane so that a face without the display unit is oriented downward.

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(Jeong teaches buttons in a second area. See Figure 1 showing a plurality of sub operation buttons in an area different from buttons 190 & 192 & of a different height. If an interactive disk is used with the system, a game is taught.

Claim 8:

Jeong teaches:

The portable electronic device of claim 7, wherein the second area is elevated from the first area. (See Figure 1, Button 194 is in a first area while Buttons 190/192 are in a second area elevated from the first area.)

Claim 9:

Jeong teaches:

The portable electronic device of claim 5, wherein spacing between the pressed surfaces of the direction instruction key and spacing between each button of the button keys are different from each other. (See Figure 1, spacing between directional buttons 192 & buttons 190 is different).

Claim 10:

Jeong teaches:

The portable electronic device of claim 5, further comprising an analog operation means for outputting an analog signal for direction (Figure 1, directional buttons 192), Jeong does not explicitly teach:

wherein the analog operation means is located closer to the user than the direction instruction key and the center of the analog operation means is located inside of the center of the direction instruction key.

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(It would have been a matter of obvious design choice to one of ordinary skill in the art at the time of Applicant's invention to place buttons in the claimed manner.)

Claims 11, 12:

Jeong teaches:

The portable electronic device of claim 1, wherein the surface of the casing is a resin molded part (the device is made of some type of resin),

Jeong does not teach:

the resin molded part comprising a transparent window through which the display unit can be viewed and a frame other than the transparent window, the transparent window being made of a first transparent resin, the frame being made from a second colored resin, wherein the first resin and the second resin are molded in a unified fashion by two-color molding.

(Jeong Figure 1 Item 126 teaches a transparent window through which a display can be viewed. The type of resin or plastic used for the frame & color scheme would have been a matter of obvious design choice to one of ordinary skill in the art at the time of Applicant's invention. Aesthetic considerations are viewed as matters of obvious design choice that are well within the level of ordinary skill in the art - this also applies to the limitations of claim 12).

Claims 13, 14:

Jeong teaches:

The portable electronic device further comprising a speaker within the casing, wherein a through hole is formed at the bottom face of the casing for emitting sounds

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generated from the speaker, the through hole being formed with an angle toward the front face of the casing.

a second through hole formed in the front face of the casing, and a duct formed inside the casing for directing sounds generated from the speaker to the second through hole.

(Jeong teaches that it is well-known in the art to place speakers at the base of the unit or on the display unit. See Col. 1. Lines 49-50. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to place speakers at the base of the unit as taught by Jeong & provide through holes & sound ducts in the claimed manner. This yields the predictable results of outputting sounds with sufficient volume & clarity.)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/

/Corbett Coburn/
Primary Examiner
AU 3714